

REMARKS

Summary of the Office Action

Claims 1-64 were pending.

Claims 8-12, 19-21, 24, and 38-64 were withdrawn from consideration without prejudice.

Claims 1-7, 13, 16-18, and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Krisch U.S. Patent No. 5,988,687 ("Krisch") in view of Mitchell U.S. Patent No. 5,368,301 ("Mitchell").

Claims 14 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Krisch in view of Mitchell and further in view of Hassenbach U.S. Patent No. 2,953,380.

Claims 23, 25, and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Krisch in view of Mitchell and further in view of Gallant U.S. Patent No. 6,517,071.

Claims 27-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Krisch in view of Mitchell and further in view of Ozrovitz U.S. Patent No. 5,213,507.

Claims 31-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Krisch in view of Mitchell and further in view of Ruben U.S. Patent No. 5,746,429.

Claim 34 was rejected under 35 U.S.C. § 102(b) as being anticipated by Mitchell.

Claim 35 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitchell.

Claims 36-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitchell in view of Jacoby U.S. Patent No. 5,368,301.

Summary of Applicant's Reply

Applicant has amended claim 34. Applicant respectfully traverses the Examiner's rejections.

Reconsideration of this application in light of the following remarks is respectfully requested.

Applicant's Response to the
Rejection Under 35 U.S.C. § 103(a)

Claims 1-7, 13, 16-18, and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Krisch in view of Mitchell.

Independent claim 1 is directed to a puzzle piece of universal shape. Neither surface of the puzzle piece includes a "portion of an overall puzzle image" (claim 1).

Krisch is directed to a sheet of puzzle pieces which may have an image printed on them by a conventional computer printer (abstract). Mitchell is directed to a double sided

puzzle, wherein the first side includes an image and the second side includes an image (abstract).

Contrary to the Examiner's contention, both Krisch and Mitchell fail to show or suggest all of the features of applicant's claimed invention. In particular, Krisch and Mitchell, either alone or in combination, each fail to show or suggest a puzzle piece with an image, wherein the image is not a portion of an overall puzzle image.

Mitchell teaches a double-sided puzzle, where each side of the puzzle portrays a complete puzzle image. See, for example, FIG. 1 and FIG. 2, which show the Mitchell puzzle. Each puzzle displays a full, overall puzzle image; each puzzle piece then contains a portion of the overall puzzle image. The Examiner admitted this when stating that a user may "solve the puzzle simply based on the image printed thereon" (Office Action, page 3).

Applicant's claim 1 is directed to puzzle pieces which do not display "a portion of an overall puzzle image". Since applicant's puzzle pieces are not connected in any way to a complete image, it would be impossible to solve a puzzle, "simply based on the image printed thereon".

Krisch also fails to show or suggest the claimed elements that Mitchell fails to show or suggest. More specifically, Krisch is directed to a puzzle sheet which one may

use in a printer, and fails to teach what type of image may be displayed on the puzzle pieces.

For at least the foregoing reasons, independent claim 1 is allowable over Krisch in view of Mitchell. Claims 2-7, 13-18, 22, 23, 25-33, which depend from independent claim 1, are also allowable over Krisch in view of Mitchell for at least the reasons that independent claim 1 is allowable over Krisch in view of Mitchell. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP § 2143. Accordingly, applicant respectfully requests that the rejection of claims 1-33 under 35 U.S.C. 103(a) be withdrawn.

Applicant's Response to the
Rejection Under 35 U.S.C. § 102(b)

Claim 34 was rejected under 35 U.S.C. § 102(b) as being anticipated by Mitchell. Applicant respectfully traverses this rejection.

Independent claim 34 is directed to a puzzle piece pad with a first puzzle piece and "at least one second puzzle piece" (claim 34). The "at least one second puzzle piece" is aligned on top of the first puzzle piece and the two pieces are attached together on one side.

The Examiner contends that applicant's feature of claim 34 is shown by the universally shaped puzzle pieces (12) of Mitchell. However, applicant's puzzle pieces are aligned on top of each other, whereas Mitchell's puzzle pieces are aligned side by side.

For at least the foregoing reasons, independent claim 34 is allowable over Mitchell. Claims 35-37, which depend from independent claim 34, are also allowable over Mitchell for at least the reasons that independent claims 34 is allowable over Mitchell.

Conclusion

For at least the reasons stated above, applicant respectfully submits that this application is in condition for allowance. Reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,



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